

REMARKS

This application has been carefully reviewed in light of the Office Action dated November 29, 2007. Claims 2, 6, 7, and 28 to 30 are in the application, with Claim 2 being independent. Claims 2, 6, and 28 to 30 have been amended herein. Reconsideration and further examination are respectfully requested.

Claim 30 was rejected under 35 U.S.C. § 112, second paragraph. The rejection is respectfully traversed, and is submitted to have been obviated by the amendments made to that claim.

Claims 2, 6, 7, and 28 to 30 were rejected under 35 U.S.C. § 102(b) over PNAS, Vol. 99, 2002, pp. 7554-7559 (Dudley). Claims 2, 6, 7, and 28 to 30 were rejected under 35 U.S.C. § 102(b) over U.S. Publication No. 2002/0051973 (Delenstarr). These rejections are respectfully traversed.

Claim 2 recites, *inter alia*, (i) the existence/non-existence or amount of the nucleic acid molecules having the target base sequences is unknown; (ii) at least two probes for an internal standard nucleic acid added at a known amount to the sample at the time of PCR amplification of the nucleic acid molecules having the target base sequences, and (iii) the at least two probes are available for quantitative evaluation of PCR of the nucleic acid molecules having the target base sequences.

Neither Dudley nor Delenstarr is seen to disclose or suggest at least the above-discussed features.

In this regard, the Office Action dismisses the functional language set forth in the above-discussed features (ii) and (iii) as recitation of intended use. However,

Applicants respectfully submit that the functional language is not a recitation of intended use. Functional language defines an element by what it does rather than what it is and is perfectly permissible claim language that cannot be ignored. See MPEP § 2173.05(g) and § 2114. Accordingly, Applicants respectfully submit that the language in features (ii) and (iii) should be given full patentable weight in claim analysis.

According to another feature of the invention as recited by Claim 2, the at least two probes have different sequences from each other and have sequences complementary to the internal standard nucleic acid.

Dudley and Delenstarr are also not seen to disclose or suggest this feature.

According to the Office Action, any of the probes disclosed in Dudley, with the exception of a probe for the target gene, corresponds to the at least two probes of the present invention. However, nowhere is Dudley seen to describe that these probes have sequences complementary to the same internal standard nucleic acid.

With respect to Delenstarr, the Office Action asserts that Delenstarr's background probes correspond to the at least two probes of the present invention. However, similar to Dudley, Delenstarr is not seen to describe that these background probes have sequences complementary to the same internal standard nucleic acid.

The dependent claims are also submitted to be patentable because they set forth additional aspects of the present invention and are dependent from the independent claim discussed above. Therefore, separate and individual consideration of each dependent claim is respectfully requested.

Claims 2, 6, and 7 were rejected for obviousness-type double patenting over Claims 1, 5, 6, 11, and 12 of U.S. Patent No. 6,924,103 (Yamamoto). Reconsideration of this rejection is respectfully requested in view of the amendments made herein.

Applicants note the indication in the Office Action that the double patenting rejection may be overcome by filing a Terminal Disclaimer. In this regard, if the double patenting rejection is maintained and no other issues remain, Applicants will consider the possibility of filing a Terminal Disclaimer.

Claims 2 and 6 received provisional rejections for obviousness-type double patenting over Claims 5 to 7 and 52 of Application No. 09/764,420, and over Claims 224, 226, 227, and 242 of Application No. 09/951,972.

Applicants note that a provisional double patenting rejection should be withdrawn and the application permitted to issue if the provisional double patenting rejection is the only rejection remaining in an application. See MPEP § 804(I)(B). Applicants submit that the provisional double patenting rejections are the only remaining issues in this application and therefore respectfully request withdrawal of the rejections.

The application is believed to be in condition for allowance, and a Notice of Allowance is respectfully requested.

No fees are believed due; however, should it be determined that additional fees are required, the Director is hereby authorized to charge such fees and any additional fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required during the entire pendency of this application, or to credit any overpayment, to Deposit Account 06-1205.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should be directed to our address given below.

Respectfully submitted,

/Damond E. Vadnais/
Damond E. Vadnais
Attorney for Applicants
Registration No. 52,310

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200

FCBS_WS 2008245v1